

## REMARKS

The Office Action of December 22, 2010 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection and objection are traversed and overcome. Upon entry of this Amendment, claims 28-41 and 43-47 remain in the application. Reconsideration of the claims is respectfully requested.

Claim 45 has been amended to correct a minor typographical error. The word "in" has been deleted.

Claims 39 and 47 stand objected to as being dependent upon a rejected base claim. The Office states that claims 39 and 47 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 39 and 47 have been so rewritten. As such, it is submitted that claims 39 and 47 are in condition for allowance.

Claims 28-31, 33-35, 37-40, 43, 45, and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goodsmith (U.S. Patent No. 4,649,753, referred to herein as "Goodsmith") in view of Krcek et al. (U.S. Patent No. 6,401,507, referred to herein as "Krcek"). Regarding independent claims 28 and 38, the Office states:

Goodsmith discloses a pierce nut installation apparatus for installing pierce nuts into a panel, the apparatus comprising a pierce nut installation head having a plunger for receiving a pierce nut 15 for installation into the panel 16 (this is conventional in the art), a plunger reciprocating in the plunger passage having a proximal end driving the pierce nuts through the plunger passage into the panel piercing a slug from the panel thereby forming an opening in the panel and installing the pierce nut into the opening in the panel left by the slug (this is conventional in the art), the plunger having an axial opening telescopically receiving a slug probe rod resiliently biased toward the proximal end of the plunger and extending beyond the proximal end of the plunger through the bore disposed in the pierce nut thereby ensuring a slug is pierced from the panel (col. 3, lines 27-68 and col. 4, lines 1-30).

Applicant respectfully submits that the Office has failed to present a *prima facie* case for obviousness. Applicant has been unable to find many of the elements

that the Office states are disclosed in Goodsmith. As such, it is submitted that the Office has not provided a clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (*KSR*) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." It is submitted that the rejection by the Office in this case has not provided articulated reasoning with some rational underpinning to support obviousness. Rather, the Office has cited long passages in the primary reference without showing how the passages relate to Applicant's disclosure as recited in the claims. The Office has failed to compare either the names or the reference numbers of elements between the primary reference and Applicant's disclosure except for the pierce nut 15 and the panel 16. As such, it is submitted that the § 103(a) rejection is a mere conclusory statement proscribed by the Supreme Court in *KSR*.

It is further respectfully submitted that even if the reasoning provided is considered to be articulated reasoning with some rational underpinning, the primary reference does not support a legal conclusion of obviousness.

The Office states that "Goodsmith discloses a pierce nut installation apparatus for installing pierce nuts into a panel, the apparatus comprising a pierce nut installation head having a plunger for receiving a pierce nut 15 for installation into the panel 16 (this is conventional in the art)." It is submitted that the statement is false because the apparatus that Goodsmith discloses is not for installing pierce nuts into a panel. Goodsmith does not disclose an apparatus comprising a pierce nut installation head. Rather, Goodsmith discloses a testing station in a testing press (Col. 3, lines 15-16). Goodsmith does not disclose a plunger for receiving a pierce nut 15 for installation into the panel 16. Rather, Goodsmith discloses an extensible

member 18 for testing for presence and proper alignment of a nut, absence of a slug, and resistance to retention pressure (Goodsmith Col. 3, line 64 – Col. 4, line18).

The Office further states that “Goodsmith discloses... a plunger reciprocating in the plunger passage having a proximal end driving the pierce nuts through the plunger passage into the panel piercing a slug from the panel thereby forming an opening in the panel and installing the pierce nut into the opening in the panel left by the slug (this is conventional in the art).” However, Goodsmith’s extensible member 18 does *not* drive pierce nuts through a plunger passage into panel 16. When Goodsmith’s extensible member 18 contacts fastener 15, the fastener is already installed in panel 16 or an installation malfunction has already occurred (see Col. 3, line 64 – Col. 4, line18). The only instance that Goodsmith’s extensible member 18 may drive fastener 15 occurs when extensible member 18 presses fastener 15 **out** of panel 16 (Col. 4, lines 14-25).

Still further, the Office states that “Goodsmith discloses... the plunger having an axial opening telescopically receiving a slug probe rod resiliently biased toward the proximal end of the plunger and extending beyond the proximal end of the plunger through the bore disposed in the pierce nut thereby ensuring a slug is pierced from the panel (col. 3, lines 27-68 and col. 4, lines 1-30). However, Goodsmith is silent throughout the entire reference, including the figures and the passage cited by the Office, regarding the extensible member 18 having an axial opening. Further, since there is no axial opening in extensible member 18, Goodsmith does not disclose a slug probe rod telescopically received in an axial opening in a plunger. Still further, Goodsmith’s spring means 40 biases the extensible member 18 (by acting on the piston) **away from** the proximal end of the extensible member 18 – not toward the proximal end as recited in claim 28.

It is submitted that Goodsmith fails to teach or render obvious Applicant’s invention as recited in independent claim 28, and Krcek fails to supply the deficiencies thereof. It is further submitted that Goodsmith in view of Krcek also fails to teach or render obvious Applicant’s invention as recited in independent claim 38

for reasons similar to those stated above regarding independent claim 28. Goodsmith fails to disclose or render obvious at least: A pierce nut installation tool for installing a pierce nut into a panel, comprising: an upper installation assembly...having a plunger with a proximal end reciprocating toward the panel for driving the pierce nut into the panel ... a die button cooperating with said proximal end of said plunger to pierce a slug from the panel into said lower installation assembly thereby forming a hole in the panel and plastically deforming the panel and fastening the pierce nut to the panel.

Claims 29-31, 33-35, 37, 39-40, 43, 45, and 46 depend ultimately from one of independent claims 28 and 38. As shown above, Goodsmith in view of Krcek fails to anticipate or render obvious independent claims 28 and 38. Therefore, claims 29-31, 33-35, 37, 39-40, 43, 45, and 46 are distinguished from Goodsmith in view of Krcek at least by the dependence on independent claims 28 and 38.

Claims 32, 36, 41 and 44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goodsmith/Krcek as applied to claims 28 and 34 above, and further in view of Baker et al. (U.S. Patent No. 5,455,848, referred herein as "Baker"). Claims 32 and 36 depend ultimately from independent claim 28; and claims 41 and 44 depend ultimately from independent claim 38. As shown above, Goodsmith in view of Krcek fails to anticipate or render obvious independent claims 28 and 38. It is submitted that Baker does not supply the deficiencies of Goodsmith in view of Krcek. As such, at least by the dependence from independent claims 28 and 38, it is submitted that claims 32, 36, 41 and 44 patentably distinguish from Goodsmith in view of Krcek in further view of Baker.

For all the reasons stated above, it is submitted that Applicant's invention as defined in independent claims 28 and 38, and in those claims depending ultimately

therefrom, is not anticipated, taught or rendered obvious by the cited reference(s), either alone or in combination, and patentably defines over the art of record.

It is submitted that the absence of a reply to a specific rejection, issue or comment in the instant Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this amendment should be construed as an intent to concede any issue with regard to any claim, except if specifically stated in this amendment, and the amendment of any claim does not signify concession of unpatentability of the claim prior to its amendment.

In summary, claims 28-41 and 43-47 remain in the application. In view of the foregoing arguments, all pending claims are believed to be in condition for allowance, and such action is respectfully requested. Therefore, this response is believed to be a complete response to the Office Action, and further and favorable consideration is respectfully requested.

If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact the undersigned attorney at the below-listed telephone number.

Respectfully submitted,

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